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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/416,902	10/13/1999	JOHN MCCAFFERTY	05569.0004.DVUS06	6750

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EXAMINER

STEELE, AMBER D

ART UNIT PAPER NUMBER

1639

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/416,902	Applicant(s) MCCAFFERTY ET AL.	
	Examiner Amber D. Steele	Art Unit 1639	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. §§ 102(a,e) regarding Dower U.S. Patent 5,427,908.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 44, 47, 48, 61, 62.
Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
please refer to the attached Advisory Action (cont.).
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____

PETER PARAS, JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Pete Paras

Advisory Action (cont.)

1. The response to the final rejection received on August 15, 2006 has been considered but is not deemed to place the application in condition for allowance.

Withdrawn Rejection

2. The rejection of claims 44, 47, and 48 under 35 U.S.C. § 102 (a, e) as being anticipated by Dower et al. U.S. Patent 5,427,908 is withdrawn due to applicants' arguments in the response received on August 15, 2006.

Arguments and Response

3. Applicants' arguments directed to the rejection under 35 U.S.C. 102 (e) as being anticipated by Ladner et al. U.S. Patent 5,837,500 for claims 44, 47, and 48 were considered but are not persuasive for the following reasons.

Applicants contend that Ladner et al. (U.S. Patent 5,837,500) "does not disclose display on filamentous bacteriophage multi-chain proteins such as Fab antibody fragments" and that Ladner et al. teaches a preferred embodiment of displaying small peptide fragments of approximately 40 amino acids in length do not read on the larger Fab antibody fragments (e.g. approximately 400 amino acids) and reference the *Penguin Dictionary of Biology* (1994). In addition, applicants contend that scFv do not read on the presently claimed invention.

Applicants' arguments are not convincing since the teachings of Ladner et al. (U.S. Patent 5,837,500) anticipate the presently claimed method of obtaining a member of a specific binding pair. It is the examiner's position that Ladner et al. disclose Fab (please refer to columns 15) wherein patents are relevant as prior art for all they contain therefore a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art

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including nonpreferred embodiments (please refer to MPEP § 2123; *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989); *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998)). In addition, Ladner et al. teaches phage display of binding proteins (please refer to columns 51-57 and claims 1, 5, 19, 20, 21). Furthermore, applicants' arguments regarding the length of the Fab antibody fragment is moot considering that the features upon which applicant relies (e.g. Fab fragment is about 400 amino acids long) is not recited in the present claims and Ladner et al. teach that Fab are 440 amino acids in length (please refer to column 15). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, the claim language of present claim 44 which recites "Fab antibody fragments" appears to be either redundant or broadening the scope of Fab. For example, it is art recognized that Fab is an acronym for antibody fragment or antigen-binding fragment (e.g. V_H, C_{H1} or C_{γ1}, V_L, C_L wherein the heavy chain and the light chain are linked via a disulfide bond) therefore the presently claimed invention claims an antibody fragment of an antibody fragment which given the broadest possible interpretation could read on scFv, V_L, V_H, etc. (please refer to MPEP § 2111). Therefore, the presently claimed invention is anticipated by the teachings of Ladner et al. (U.S. Patent 5,837,500).

4. Applicants' arguments directed to the rejection under 35 U.S.C. 102 (a or e) as being anticipated by Ladner et al. U.S. Patent 6,979,538 (U.S. Patent application 2002/0150881) for claims 44, 47, 48, 61, and 62 were considered but are not persuasive for the following reasons.

Applicants contend that Ladner et al. (U.S. Patent 6,979,538) “does not disclose display on filamentous bacteriophage of a multi-chain polypeptide including Fab fragment of an antibody” and scFv are not multi-chain antibody fragments.

Applicants’ arguments are not convincing since the teachings of Ladner et al. (U.S. Patent 6,979,538) anticipate the presently claimed method of obtaining a member of a specific binding pair. It is the examiner’s position that Ladner et al. (U.S. Patent 6,979,538) teach Fab (please refer to column 15) wherein patents are relevant as prior art for all they contain therefore a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art including nonpreferred embodiments (please refer to MPEP § 2123; *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989); *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998)). In addition, Ladner et al. teach phage display of binding proteins (please refer to columns 48-57 and claims 1, 3, 4, 7, 8, 9, 10, 11, 12, 15, 16, 17). Furthermore, applicants’ arguments regarding that the Fab antibody fragment must be a multi-chain is moot considering that the features upon which applicant relies (e.g. multi-chain) is not recited in the present claims and Ladner et al. teach that Fab which are multi-chain (please refer to column 15). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, the claim language of present claim 44 which recites “Fab antibody fragments” appears to be either redundant or broadening the scope of Fab. For example, it is art recognized that Fab is an acronym for antibody fragment or antigen-binding fragment (e.g. V_H, C_{H1} or C_{γ1}, V_L, C_L wherein the heavy chain and the light

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chain are linked via a disulfide bond) therefore the presently claimed invention claims an antibody fragment of an antibody fragment which given the broadest possible interpretation could read on scFv, V_L, V_H, etc. (please refer to MPEP § 2111). Therefore, the presently claimed invention is anticipated by the teachings of Ladner et al. (U.S. Patent 6,979,538).

Future Communications

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amber D. Steele whose telephone number is 571-272-5538. The examiner can normally be reached on Monday through Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ADS

August 30, 2006